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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,282	07/08/2003	William E. MOERNER	12665.0029.NPUS01	1281

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EXAMINER

HAQ, SHAFIQUH

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/604,282	Applicant(s) MOERNER ET AL.	
	Examiner Shafiqul Haq	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5,8,10,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5,8,10,12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendments filed May 12, 2006 is acknowledged and entered.
2. Claims 1-2, 6-7, 9, 11 and 14-40 have been cancelled. Accordingly claims 3-5, 8, 10 and 12-13 are pending and are examined on merits.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 8, 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "wherein when the donor atom is a nitrogen atom, R¹-R⁴ are not alkyl groups or fluoroalkyl groups" do not have support in the specification because specification do not indicate or explicitly describe this negative limitation for the exclusion of alkyl groups or fluoroalkyl groups for R¹-R⁴ when the donor atom is nitrogen. On the contrary, specification cites plenty of examples of fluorophore compounds wherein when donor atom is nitrogen, R¹-R⁴ are alkyl or fluoroalkyl groups (see compounds 1-26 and 33 of figs. 1-8 and 11).
5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 3 recites the phrase "D is a donor group comprising an oxygen atom conjugated with A". It is not clear whether oxygen of the donor group acts as a donor atom here (i.e. whether oxygen atom of donor group directly links to A is not clear). Note that in remarks of 5/12/06, applicants state "claims 3 and 4 have been amended to delete the structure formula on the right as the donor atom being an oxygen atom or a sulfur atom only requires one R group ----", but in amended claim 3, it is still unclear whether oxygen is the donor atom in the donor group D that links to A.
8. Claim 4 recites the phrase "D is a donor group comprising a sulfur atom". It is not clear whether sulfur of the donor group acts as a donor atom here (i.e. sulfur atom of the donor group directly links to A is not clear). Note that in remarks of 5/12/06, applicants state "claims 3 and 4 have been amended to delete the structure formula on the right as the donor atom being an oxygen atom or a sulfur atom only requires one R group ----", but in amended claim 4, it is still unclear whether sulfur is the donor atom in the donor group D that links to A.
9. Claim 5 recites the phrase "D is a donor group comprising a phosphorous atom". It is not clear whether phosphorous of the donor group acts as a donor atom here (i.e. phosphorous atom of the donor group directly links to A). Note that in remarks of

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5/12/06, applicants state "claims 3 and 4 have been amended to delete the structure formula on the right as the donor atom being an oxygen atom or a sulfur atom only requires one R group ----". Amended claim 5 recites that donor group comprises phosphorous atom but it is unclear whether phosphorous atom is the donor atom in the donor group D that links to A.

Response to Applicant's argument

10. Applicant's arguments filed 5/12/06 have been fully considered, but they are not persuasive to overcome all the rejections under 35 U.S.C. 112 second paragraph. As discussed on paragraphs 6-9 of this office action, it is unclear whether oxygen, sulfur or phosphorous atom serves as the donor atom in the donor group of fluorophore compounds of claims 3-5.

Applicants' incorporation of the phrase "wherein when the donor atom is a nitrogen atom, R¹-R⁴ are not alkyl groups or fluoroalkyl groups", do not have support in the specification. However, rejections under 35 USC 102 of last office action (1/9/06) are withdrawn in view of incorporation of the negative limitation "wherein when the donor atom is a nitrogen atom, R¹-R⁴ are not alkyl groups or fluoroalkyl groups", but applicants is advised that this rejection would be reinstated if the phrase "wherein when the donor atom is a nitrogen atom, R¹-R⁴ are not alkyl groups or fluoroalkyl groups" were deleted from claims 8, 12 and 13.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shafiqul Haq whose telephone number is 571-272-6103. The examiner can normally be reached on 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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